



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,332	08/20/2001	Gregory P. Fitzpatrick	BOC9-2001-0007 (242)	5985

40987 7590 10/10/2006

AKERMAN SENTERFITT  
P. O. BOX 3188  
WEST PALM BEACH, FL 33402-3188

EXAMINER

BILGRAMI, ASGHAR H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/933,332

Applicant(s)

FITZPATRICK ET AL.

Examiner

Asghar Bilgrami

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-30, 36 and 39-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-30, 36, 39-64 is/are rejected.
- 7) ☒ Claim(s) 4 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

***Claim Objections***

1. Claims 4 & 39 are objected to because of the following informalities: They indicate to be dependent on a cancelled claim. For examining purposes the examiner assumed them to depend on their respective independent claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-30, 36, 39-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudjonsson et al (U.S. 6,564,261 B1) and Tornabene et al (U.S. 2002/0023132 A1)

4. As per claims 1, 13-15, 16, 19, 25, 28, 29, 30, 48-51, 53, 54, 18, 23, 28, 36 & 58 Gudjonsson disclosed a method for sharing contact list information between participants of a chat session, comprising: identifying a first contact list containing contact information relating to contacts of said first chat session participant and identifying a second chat participant having a second contact list containing contact information relating to contacts of the second chat participant, said first chat session participant and said second session participant participating within a common chat session; providing the second chat participant with access to contact information contained within the first contact list (col.24, lines 32-43, col.25, lines 6-20, col.27, lines 36-44, col.29, lines 64-67 & col.30, lines 1-30). However Gudjonsson did not explicitly disclose selecting the first contact list; selecting the second contact list; comparing said first contact list and said second contact list; identifying common and non-common contacts between said first contact list and said second contact list; displaying common contacts in a first visual list and non –common contacts in a second visual list (Page 1, paragraph.7); determining whether said first contact list is modifiable by said second chat session participant and modifying said first contact list by said second chat session participant to include non-common contacts if said first contact list is modifiable by said second chat session participant, wherein modifying comprises the step of adding non-common contact information to said first contact list the contact information pertaining to parties other than the first and second chat session participants; and providing the first session participant with access to information contained within said second contact list. In the

Art Unit: 2143

same field of endeavor Tornabene disclosed determining whether said first contact list is modifiable by said second chat session participant and modifying said first contact list by said second chat session participant if said first contact list is modifiable by said second chat session participant, wherein modifying comprises the step of adding contact information to said first contact list the contact information pertaining to parties other than the first and second chat session participants; and providing the first session participant with access to information contained within said second contact list (paragraphs. 6-8 & 77).

At the time the invention was made it would have been obvious to one in the ordinary skill in the art to have incorporated the capability of first participant to modify the contact list of the second participant as disclosed by Tornabene in a method of sharing contact list information as disclosed by Gudjonsson in order to achieve greater flexibility in information sharing among chat participants resulting in more interacting and enhanced chat session experience.

5. As per claims 24 & 59 Gudjonsson disclosed a method for providing contact management in a chat session, comprising: identifying a first chat session participant maintaining a first contact list containing contact records relating to contacts of first chat session participant, identifying a second chat participant having a second contact list containing contact records relating to contacts of second chat session participant and identifying a third chat participant having a third contact list containing contact records relating to contacts of third chat session participant, said first chat session participant,

Art Unit: 2143

said second session participant, and said third chat session participant participating within a common chat session (col.24, lines 32-43, col.25, lines 6-20, col.27, lines 36-44, col.29, lines 64-67 & col.30, lines 1-30). However Gudjonsson did not explicitly disclose sending a token of recommendation originated by the first chat session participant to the second chat session participant, said token of recommendation providing a recommendation for said second chat participant; transferring said token of recommendation to third chat session participant who is known to first chat session participant; and if said third chat session participant accepts said token of recommendation, modifying said third contact list with contact information for said second chat session participant. In the same field of endeavor Tornabene disclosed sending a token of recommendation originated by the first chat session participant to the second chat session participant, said token of recommendation providing a recommendation for said second chat participant; transferring said token of recommendation to third chat session participant who is known to first chat session participant; and if said third chat session participant accepts said token of recommendation, modifying said third contact list with contact information for said second chat session participant (paragraphs. 6-8 & 77).

At the time the invention was made it would have been obvious to one in the ordinary skill in the art to have incorporated the capability of first participant to modify the contact list of at least one other participant as disclosed by Tornabene in a method of sharing contact list information as disclosed by Gudjonsson in order to achieve greater flexibility

Art Unit: 2143

in information sharing among chat participants resulting in more interacting and enhanced chat session experience.

6. As per claims 17, 20, 52, 55 & 60 Gudjonsson-Tornabene disclosed 17 the method according to claim 16, further comprising the steps of: determining if said first contact list is modifiable by said second participant to the communication session; and if said first contact list is modifiable by said second participant, adding selected dissimilar contact records to said first contact list. (Tornabene, paragraphs. 6-8 & 77).

7. As per claims 4, 5, 6, 7, 21, 22, 39, 40, 41, 42, 56, 57, 63 & 64 Gudjonsson-Tornabene disclosed the GUI according to claim 40, further comprising the step of displaying an icon within a chat session interface used by the first chat session participant to indicate whether said second contact list is accessible to said first session participant (Gudjonsson col.25, lines 6-20 col.26, lines 59-67 & col.27, lines 1-4 col.30, lines 1-16 & col.26, lines 40-58).

8. As per claims 8 & 43 Gudjonsson-Tornabene disclosed the method according to claim 1, further comprising the steps of: identifying a third chat session participant maintaining a third contact list containing contact information relating to contacts of said third chat session participant, said third chat session participant participating within said common chat session; and providing the third session participant with access to the contact information contained within the first contact list and the second contact list and

Art Unit: 2143

providing the first chat session participant and said second session participant with access to contact information contained within the third contact list (Gudjonsson col.4, lines 31-33, col.29, lines 64-67, col.30, lines 1-16 & col.26, lines 40-58).

9. As per claims 9 & 44 Gudjonsson-Tornabene disclosed the method according to claim 8, further comprising the steps of: permitting the selection of said displayed icon for said first contact list and said displayed icon for said second contact list by a third chat session participant having a third contact list; comparing said selected first contact list and said selected second contact list to said third contact list (col.30, lines 1-16 & col.26, lines 40-58); and displaying to said third chat session participant contacts that are common to said first selected contact list, said second selected contact list, and said third contact list according to results from said comparing step (Gudjonsson col.30, lines 15-29).

10. As per claims 10, 24, 26, 27, 45, 59 & 61, 62 Gudjonsson-Tornabene disclosed the method according to claim 9, further comprising the steps of: permitting any of said first chat session participant, said second chat session participant and said third chat session participant to modify any of said first contact list, said second contact list and said third contact list (col.27, lines 36-44) according to results from said comparing step col.26, lines 37-58); and permitting any of said chat session participants associated with said contact list to reject said modification (Gudjonsson col.25, lines 6-20).



11. As per claims 11, 12, 47 & 46 Gudjonsson-Tornabene disclosed the method according to claim 7, wherein if said display icon indicates that said first contact list is not modifiable, further comprising the step of requesting said first chat session participant to allow said second chat session participant to modify said contact list (Gudjonsson col.25, lines 21-42).

### ***Response to Arguments***

12. Applicant's arguments filed 07/07/2006 have been fully considered but they are not persuasive.

13. Applicant's arguments are only directed towards Gudjonsson from page 18-22 in which the applicant argues that Gudjonsson does not disclose contact lists and user sharing contacts.

14. In response to applicant's arguments against the reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references which in this case is Gudjonsson and Tornabene. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally Gudjonsson reference clearly discloses users communicating via a chat session in and sharing contact lists with each other (see figure 8, col.27, lines 36-61 & col.29, lines 64-67 & col.30, lines 1-30). Please see 103 rejections on line 4 of this office action, which addresses the limitations of the recently amended claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on 9-5.

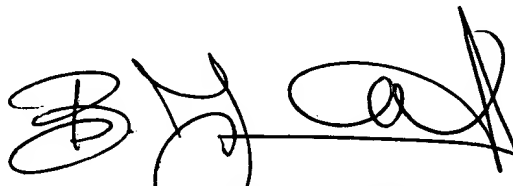
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3924. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



AB



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER